

Appl. No.: 10/771,805  
Amdt. Dated: 07/26/2007  
Off. Act. Dated: 04/26/2007

### **REMARKS/ARGUMENTS**

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

1. Withdrawal of Finality of Prior Office Action.

The Applicant notes with appreciation that the Examiner has withdrawn the finality of the prior office action.

2. Introduction.

In the instant action, all pending claims have been rejected based on obviousness in view of the combined teachings of Satomi et al. (U.S. Pat. Publ. No. 2003/0063304) and Ohta (U.S. Patent No. 7,188,224). Satomi et al. has been cited by the Examiner in prior actions, and the Ohta reference has been cited for the first time in the instant action.

The Applicant notes that Claims 1-10 and 17-24 had been previously rejected under 35 U.S.C. § 102 based on Satomi et al., but the Applicant overcame that rejection in its response filed on October 16, 2006. In addition, in that same response, the Applicant argued that Claims 1-10 and 17-24 were not obvious in view of Satomi et al., and the Examiner accepted the Applicant's arguments in that regard.

The Examiner issued a further action on November 20, 2006, and rejected Claims 1-10 and 17-24 for obviousness based on the combined teachings of Satomi et al. and Lamkin et al. (U.S. Pat. Publ. No. 2006/0159109). This rejection has been withdrawn, and the rejection based on the combination of Satomi et al. and Ohta was issued.

Because the Applicant has previously discussed the Satomi et al. reference in detail in prior responses, the Applicant will not re-hash that discussion in the interest in brevity. Instead, the Applicant will address the newly-cited Ohta reference and the merits of use of that reference to support an obviousness rejection. However, the Applicant does incorporate by reference the Applicant's discussion of Satomi et al. found in the Applicant's prior responses.

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that those claims were not rendered obvious by Satomi et al.

3. Rejection of Claims 1-10 and 17-28 under 35 U.S.C. § 103.

Claims 1-10 and 17-28 were rejected herein under 35 U.S.C. § 103 as being obvious in view of the combined teachings of Satomi et al. (U.S. Pat. Publ. No. 2003/0063304) and Ohta (U.S. Patent No. 7,188,224). Claims 1, 10, 17, and 26-28 are independent.

The Applicant respectfully traverses the rejection for the following reasons.

(a) The cited combination does not teach what the Examiner purports it to teach. More particularly, the Applicant respectfully submits that the Ohta reference has been misapplied.

For example, the Examiner states that

"On the other hand, Ohta discloses duplicates of said specific content are retained across multiple devices configured for communicating with one another over a network (column 34, lines 58-64, Ohta) and response to the request based on the presence of any duplicate or related content (column 36, lines 7-29, Ohta)."

However, Ohta does not teach responding to a request based on the presence of any duplicate or related content, as can be seen from the following passage cited by the Examiner (col. 36, lines 7-29):

"The permitted number of duplications represents the right to duplicate the content to another device up to that number of times. Note that the permitted number of duplications is a sum of two numbers that are permitted separately for duplications to a first type device and to a second type device. The first type device refers to a device that duplicates a content to a non-portable recording medium, and the second type device refers to a device that duplicates a content to a portable recording medium. As shown in FIG. 21, the permitted number of duplications in content information 1121 is "10 (first type: 5, and second type: 5)", which means that it is permitted to duplicate the content to a first type device up to five times, and to a second type device up to another five times.

The flag indicating whether or not content duplication to an out-group device is permitted is set to either "OK" or "NG". When set to "OK", the flag indicates that duplication of the content to an out-group device is permitted. When set to "NG", on the other hand, the flag indicates that duplication of the

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content to an out-group device is prohibited. As shown in FIG. 21, the flag in this embodiment is set to "NG", which means that duplication of content 1122 to an out-group device is prohibited."

As can be seen both from the language above that was cited by the Examiner, as well as reading Ohta and its considering its context, the reference has been misapplied.

Here, Ohta is not teaching responding to a request based on the presence of any duplicate or related content, but instead, is teaching the conditions under which information can be duplicated. Ohta describes checking to see if a permitted number of duplications has been exceeded and, if not, allowing information to be duplicated. On the other hand, if the permitted number of duplications has been exceeded, then duplication is prohibited. Ohta is not describing management of duplicates of content that is stored at multiple locations for access for access by a user as recited in the Applicant's claims; Ohta is only describing how to limit the number of duplicates that can be made.

Moreover, Ohta does not teach that duplicates of said specific content are retained across multiple devices configured for communicating with one another over a network as asserted by the Examiner. The following passage cited by the Examiner (col. 34, lines 57-64) discloses no such configuration:

"Content duplication management system 1000 is a system for receiving contents that are broadcast from a broadcast station or transmitted over a network, and for allowing the member devices of a group formed by AD server 100 to use the received contents. Hereinafter, a description is given of an example in which content duplication management system 1000 receives contents from a broadcast station."

Here, Ohta is not teaching duplicates of specific content being retained across multiple devices configured for communicating with one another over a network, but instead, is merely describing a system where content is moved from one location to another over a network; e.g., where content is copied from one location to another.

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Ohta is not describing management of duplicates of content that is stored at multiple locations for access for access by a user.

Clearly, the cited portions of Ohta have absolutely nothing to do with reviewing a record associated with a specific content in response to a request and analyzing the associated record to determine what duplicate or related content is available across multiple devices, selectively transmitting a confirmation for the request based on the reviewing and the presence of any duplicate or related content, and performing the request in response to receiving the request and instruction from the user in responding to said confirmation as recited in the Applicant's claims. It is undisputed that Ohta describes management of duplication; that is, how to control the number of duplicates that are being made. However, Ohta does not teach how to manage the distribution of content where the duplicates of the content reside on multiple devices.

For the foregoing reasons, Ohta has been misapplied and does not constitute relevant art. Whether Ohta is art which is analogous to Satomi et al. as asserted by the Examiner or not, a skilled artisan would not be motivated to combine the two references in order to arrive at the present invention for the clear reason that they combination does not, in fact, arrive at the present invention or even come close to doing so. The Applicant's claims recite a combination of elements which is neither taught by Satomi and Ohta, nor rendered obvious by those references. There mere fact that Ohta uses the words "duplicate", "duplicates" or "duplication" does not transform that reference into one which supplies what Satomi et al. lacks to support a rejection.

Therefore, the Applicant respectfully submits that Claims 1-10 and 17-28 are patentable over the cited references.

(b) Lastly, with regard to Claim 10, the Examiner's action fails to address the fact that this claim is written in means plus function form under 35 U.S.C. §112, sixth paragraph, and respectfully traverses the rejection of Claim 10 based on *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(en banc).

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In rejecting Claim 10, the Examiner made no specific fact findings as to the scope of equivalents for the four (4) means plus function elements in the claim. An examiner "construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure ... described therein, and equivalents thereof," *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(en banc). The Federal Circuit held that the Donaldson decision sets "a limit on how broadly the PTO may construe means-plus-function language under the rubric of 'reasonable interpretation.'" *Id.* at 1194. In other words, an examiner's claim interpretation is not "reasonable" if it is not based on the specification's description of the implementation of the means element of the claim. The court then said, "Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such [means-plus-function] language when rendering a patentability determination." *Id.* at 1195.

Here, as in *Donaldson*, the Examiner is required by statute to look to the Applicant's specification and construe the "means" language as referring to corresponding means disclosed in the specification and equivalents thereof." See *Id.* at 1195. However, the Examiner did not construe the means language of these claims, however. Nor did the Examiner find, on the basis of specific facts of record here, that the means disclosed in the Applicant's specification were equivalent to that of the cited references. Instead, the Examiner simply presumed equivalence.

In view of the above, the Applicant respectfully submits that the rejection of Claim 10 lacks proper foundation, and requests that the rejection be withdrawn and that Claim 10 be allowed.

#### 4. Conclusion.

Based on the foregoing, the Applicant respectfully requests that the various grounds for rejection in the Office Action be withdrawn and that a Notice of Allowance be issued for Claims 1-10 and 17-28.

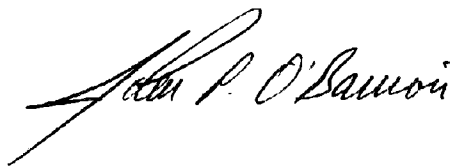
In the event any further matters remain at issue with respect to the present

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application, Applicants respectfully request that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this application.

Date: July 26, 2007

Respectfully submitted,

A handwritten signature in black ink, reading "John P. O'Banion". The signature is written in a cursive style with a large, sweeping initial 'J'.

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